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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/120,105	09/10/1993	ANDREAS WINTER	HOE92F294	1612

23416 7590 07/09/2002

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EXAMINER

WILSON, DONALD R

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 07/09/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

AS-39

<b>Advisory Action</b>	Application No: 08/120,105		Applicant(s) WINTER ET AL.	
	Examiner D. R. Wilson		Art Unit 1713	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 June 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☒ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 15,17-19,21,25 and 27-32.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

D. R. Wilson  
Primary Examiner  
Art Unit: 1713

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**ADDITIONAL COMMENTS*****Response to Proposed Amendment After Final***

1. Applicant's proposed amendment filed 6/17/02, after final rejection, has been fully considered with the following results. Applicant's multiple submissions of what were apparently intended to be the same documents creates confusion especially when the documents are not the same. The first version was received by FAX on May 29, 2002, minus any attachments, and was acted on resulting in the Advisory Action of 6/10/02. The second version with attachments was received in the Office on May 11, 2003, certified to have been mailed on 5/29/02. The clerical staff marked it as a copy and placed it in the file, as from the cover page it appeared to be identical. Applicant then submitted a third version by FAX on 6/17/02 with attachments, which this advisory action responds to, now taking into account the ISO 3146, which was not attached to the first version received. It is requested that in the future the FAX number to the Examiner's desk not be used to submit amendments unless the Examiner has requested applicant to do so.

2. The proposed amendment will not be entered because it would introduce new matter, which requires further consideration. The Examiner does not find support for the amendment as is alleged. Specifically, the Examiner does not agree that the peak would have been known to collectively refer to the peaks present in a multimodal DSC curve. To the degree that applicants have referred to ISO 3146 to support their argument, this has not been deemed to be persuasive. Applicant relies on the definition at 13.4 in ISO 3146 to support the argument that the peak in a bimodal or multimodal curve refers to the entire curve starting from when it leaves the baseline to the point where it returns. This is not deemed to be persuasive because it seems clear that what is being discussed at 13.4 is not a bimodal or polymodal curve. The figure referenced at 13.4 is not a bimodal or polymodal curve, and 13.4 also has the following note:

"A peak is attributable to the occurrence of some single process. It is normally characterized by a deviation from the established baseline, a maximum deflection, and a reestablishment of a baseline, not necessarily identical to that before the peak." (underlining added).

A bimodal or multimodal curve would clearly be representative of more than a single process, and thus would clearly be considered to contain more than one peak. It is interesting that applicant appears to

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acknowledge that the DSC curve could contain two clearly resolved peaks or nearly resolved peaks and concludes that "pure logic" then teaches that the width determined at half peak height, or quarter peak height is the sum of the peak widths at half or quarter peak heights. Why this would be more logical than including the distance between the peaks is not clear and what is called "pure logic" is clearly a misnomer.


3. The outstanding rejection to new matter is maintained because the amendment intended to correct this issue has not been entered.
4. The rejections under 35 U.S.C. § 112, first and second paragraph are maintained for reasons of record. If entered the amendment would have overcome the rejection under 35 U.S.C. § 112, second paragraph in regards to the deletion of the phrase "of R<sup>a</sup> and R<sup>b</sup>" in line 9 of Claim 17. It is noted that ISO 3146 at 17.2.2 supports the examiners position that the melting behavior is a function of the thermal history of the sample. It is not seen that because this is known that applicant has therefore erased the thermal history as set forth in ISO 3146, which is not cited as the test method used. Further, as set forth at 19 in ISO 3146 a number of variables should be set forth in reporting results including (e) previous thermal history of the sample and (f) conditioning.
5. The rejection under 35 U.S.C. § 112, fourth paragraph, is maintained because applicants traversal does not address the merits of the stated rejection.
6. Applicant's willingness to file a terminal disclaimer to overcome the double patenting rejection is noted. However, as a terminal disclaimer has not been received the rejection is maintained.

#### ***Future Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. R. Wilson whose telephone number is 703-308-2398.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 703-308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-305-3599 for After Final communications. The unofficial direct fax phone number to the Examiner's desk is 703-872-9029.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-2351.



**D. R. WILSON**  
**PRIMARY EXAMINER**